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REMARKS

Claims 16 – 25 are in the application. Claim 16 is currently amended and claims 17 – 25 were previously presented. Claim 16 is the sole independent claim herein.

No new matter has been added to the application as a result of the amendments submitted herewith. Reconsideration and further examination are respectfully requested.

Claim Rejections – 35 USC § 101

Claims 16-25 are rejected under 35 U.S.C. 101 on the basis that the claimed invention is directed to non-statutory subject matter.

In an effort to advance prosecution of the present application, Applicant has amended claim 16 consistent with the Examiner's stated "cure". Accordingly, Applicant respectfully submits that claim 16, at least as now amended, overcomes the rejection thereof under 35 USC 101. Claims 17 – 25, directly or indirectly, depend from claim 16.

Therefore, the reconsideration and withdrawal of the rejection of claims 16 – 25 under 35 USC 101 are respectfully requested.

Claim Rejections – 35 USC § 112

Claims 16 – 25 were rejected under 35 U.S.C. 112, first paragraph, on the basis that the specification, while being enabling for a determining a first delta sensitivity, does not reasonably provide enablement for executing a trade in an immunizing instrument for other (e.g., 2nd order) sensitivities. This rejection is respectfully traversed.

MPEP 2164.04 states, "the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In re

Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. (emphasis added) In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. 439 F.2d at 224, 169 USPQ at 370."

Independent claim 16 recites, in relevant part regarding the rejection under 35 USC 112, 1st paragraph, "execute a trade in an immunizing instrument having a second sensitivity value substantially equal in magnitude and opposite in value of the first sensitivity value." Applicant's specification discloses, "[T]he method includes determining a first sensitivity value of a portfolio to underlying market conditions, trading in an immunizing instrument having a second sensitivity value substantially equal in magnitude and opposite in value of the first sensitivity value, and trading in a qualifying instrument having a third sensitivity value substantially equal to the first sensitivity. (emphasis added) (See Specification, page 7, ln. 20 – 24)

The Specification also states, "[M]ethods of the invention may be implemented in a computer apparatus that includes a processor, database, and stored instructions to configure the processor to process data in accordance with methods of the

invention.” (See Specification, page 8, ln. 7 – 9) Further enabling support for the claimed invention may be found in the Specification at page 11, ln. 25 – page 12, ln. 19, wherein Applicant further discusses a “2nd Component” transaction (e.g., trading in the immunizing instrument).

Thus, it is clear that the Specification provides a disclosure of a method and apparatus in a manner and terms that correspond in scope to claimed invention.

Furthermore, the Examiner has not provided any basis to doubt the statements of Applicant’s Specification.

Accordingly, Applicant respectfully submits that claim 16 is fully and adequately enabled by the Specification. Claims 17 – 25, directly or indirectly, depend from claim 16. Therefore, Applicant respectfully submits that each of the pending claims 16 – 25 is fully enabled by the Specification under 35 USC 112, 1st paragraph.

Accordingly, the reconsideration and withdrawal of the rejection of claims 16 – 25 under 35 USC 112, 1st paragraph are respectfully requested, as is the allowance of same claims.


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CONCLUSION

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,

October 5, 2006
Date


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